

## **REMARKS**

This application has been reviewed in light of the Office Action mailed December 27, 2007. Reconsideration of this application in view of the below remarks is respectfully requested. Claims 28, 29 and 32 are pending in the application with Claims 28, 29 and 32 being in independent form. By the present amendment, Claims 28, 29 and 32 are amended, and Claim 33 is newly added.

Support for the amendment to Claims 28, 29 and 32, and the features recited in newly added Claim 33 can be found throughout the disclosure as originally filed. For example please refer to page 15, lines 9 – 10 of the specification. Claim 33 recites features similar to the features recited in Claim 29. Therefore, no new subject matter is introduced into the disclosure by way of the present amendment.

### **I. Rejection of Claims 28, 29 and 32 Under 35 U.S.C. § 103(a)**

Claims 28 and 29 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 5,761,618 issued to Lynch et al. in view of U.S. Patent No. 6,122,503 issued to Daly. Claim 32 is rejected under 35 U.S.C. § 103(a) as allegedly obvious over Lynch et al. in view of Daly and further in view of U.S. Patent No. 6,125,280 issued to Grandhi et al.

Lynch fails to teach or suggest a “...means for receiving a message that includes a first list of a plurality of network identifiers that are available for a potential handover from the mobile communication network with which the user equipment is connected...” recited in Claim 29, 32 and 33 and similarly recited in Claim 28.

Specifically, the Examiner argues that the claimed “first list of a plurality of network identifiers that are available for a potential handover” corresponds to the preferred SID list disclosed in col. 12, lines 1-8 of Lynch. However, the preferred SID list of Lynch is not a list of

networks available for hand-off. Col. 12, line 3 of Lynch recites “The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off”. That is, SIDs in the preferred SID list are not necessarily available for hand off. Therefore, the preferred SID list of Lynch does not correspond to the “first list” recited in claim 29.

Also, the “received SIDs” of Lynch does not correspond to the claimed “first list of a plurality of network identifiers that are available for a potential handover”. Specifically, the mobile subscriber unit of Lynch receives SIDs and compares them to the preferred SID list stored in the unit.

In Lynch, the mobile subscriber unit receives the SIDs by scanning the wireless systems available for hand-off. (See: col. 8, lines 16 – 26; and col. 11, line 59 – col.12, line 5). Thus, each network provides its own SID to the mobile subscriber unit, rather than the network to which the mobile subscriber unit is connected providing a list of a plurality of network identifiers that are available for a potential handover as recited in Applicant’s claims. That is, the unit of Lynch does not receive the plurality of SIDs from the wireless system (communication network) to which it is connected. Therefore, the “received SIDs” of Lynch does not correspond to the claimed “first list” recited in claim 29.

In addition, Daly and Gandhi fails to teach or suggests the “means for receiving a message that includes a first list of a plurality of network identifiers that are available for a potential handover, from the communication network with which the user equipment is connected” recited in Claims 29, 32 and 33 and similarly in Claim 28.

Therefore, for at least the reasons provided above, Claims 28, 29, 32 and 33 are believed to be allowable over the cited prior art references. Accordingly, Applicant respectfully requests

withdrawal of the rejections with respect to Claims 28, 29 and 33 under 35 U.S.C. § 103(a) over Lynch in view of Daly and further in view of Gandhi.

### CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 28, 29, 32 and 33 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



Paul J. Esatto, Jr.

Registration No. 30,749

SCULLY, SCOTT, MURPHY & PRESSER, P.C.  
400 Garden City Plaza - Ste. 300  
Garden City, New York 11530  
(516) 742-4343

PJE/DAT:jam